REMARKS

Reconsideration of the present application and entry of the present amendment are respectfully requested.

By means of the present amendment, claims 8 and 16 have been amended to correcting typographical or grammatical errors. The claims were not amended in order to address issues of patentability and Applicant respectfully reserves all rights they may have under the Doctrine of Equivalents.

In the Final Office Action, claims 1-2, 4-9, 11-18 and 21-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over International Publication No. WO 01/15449 A1 (Vamparys) in view of U.S. Patent No. 5,758,257 (Herz) and U.S. Patent No. 6,445,398 (Gerba). Applicant respectfully traverses this rejection and submits that claims 1-2, 4-9, 11-18 and 21-24 are patentable over Vamparys, Herz and Gerba for at least the following reasons.

Vamparys is directed to a method and apparatus for creating recommendations from profiles of users. A user agent is used to collect information and store them in a user profile database, as well as transmit a list of program recommendations for users to

user terminals. As correctly noted by the Examiner, Vamparys does not teach or suggest "reporting the recommendation to the user through a celebrity agent while simultaneously displaying an image of the celebrity agent", as recited in independent claim 1, and similarly recited in independent claims 8 and 15-17. Herz and Gerba are cited in an attempt to remedy these deficiencies in Vamparys.

Herz is directed to a system and method for scheduling broadcast of and access to video programs user customer profiles. As recited on column 49, lines 1-4:

> each customer can adopt the customer profiles of other individuals or programs such as "celebrity" profiles including the viewing preferences of different celebrities.

Further, Gerba teaches on column 18, lines 55-58:

> an animated or taped or live video host 300 introduces the viewer to upcoming or currently available programs 302 and provides suggestions designed to assist the viewer in reviewing programming choices. (Emphasis added)

It is respectfully submitted that Vamparys, Herz, Gerba, or combination, thereof, does not teach or suggest:

> reporting the recommendation to the user through a celebrity agent while simultaneously displaying an image of the celebrity agent.

(Emphasis added)

as recited in independent claim 1, and similarly recited in independent claims 8 and 15-17. At best and for argument sake assuming combining Vamparys, Herz and Gerba is proper, any such combination teaches to use a host to provide suggestion based on the user profile or based on a celebrity profile.

There is no teaching or suggestion in Vamparys, Herz Gerba, or combinations thereof of having a celebrity report the recommendation. The host of Gerba is just that, a host. Using a celebrity for the host is nowhere taught or suggested in Gerba.

The prior art must be examined in light of the teachings of the prior art. The prior art may not be examined utilizing the teachings of the present application. There can be no suggestion or motivation to modify a reference if the proposed modification changes the principle of operation the reference.

Applicant respectfully submits that present invention as recited in independent claims 1, 8 and 15-17 can only be arrived using impermissible hindsight. There is nothing whatsoever in Vamparys, Herz, Gerba, or combinations thereof, to suggest reporting the recommendation to the user through a celebrity agent

while simultaneously displaying an image of the celebrity agent.

When Vamparys, Herz and Gerba are reviewed without utilizing the teachings of the present application, Vamparys, Herz, Gerba, and combinations thereof, do not disclose or suggest using a celebrity agent as recited in independent claims 1, 8 and 15-17. Without utilizing the teachings of the present application as a road map and hindsight reasoning, a person skilled in the art could not, in an obvious manner, arrive at the present invention as recited in independent claims 1, 8 and 15-17.

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that "to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction - an illogical and inappropriate process by which to determine patentability." (Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996). "To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect

of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited references omitted).'" (In re Kotzab, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000).

Accordingly, it is respectfully submitted that independent claims 1, 8 and 15-17 should be allowable, and allowance thereof is respectfully requested. In addition, it is respectfully submitted that claims 2, 4-7, 9, 11-14, 18 and 21-24 should also be allowed at least based on dependence from independent claims 1, 8 and 17, as well as for the separately patentable elements contained in each

of the dependent claims.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Applicants reserve the right to submit further arguments in support of the above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

In view of the above, it is respectfully submitted that the present application is in condition for allowance, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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